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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,711	07/02/2001	Keng Kit Yeo	PHN17.710	8614
24737	7590	09/07/2004	EXAMINER	
PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510			FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/869,711	YEO, KENG KIT	
	Examiner	Art Unit	
	Lawrence D. Ferguson	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 June 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,6-10,13,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 25 and 26 is/are allowed.
- 6) Claim(s) 1-3,6,9,10 and 13 is/are rejected.
- 7) Claim(s) 7 and 8 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 July 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed June 21, 2004. Claims 25 and 26 were added, rendering claims 1-3, 6-10, 13 and 25-26 pending.

New Matter - 35 U.S.C. 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase, "...an anodized layer which supports said outer layer" is not supported by the specification.

Objection to specification

4. The amendment filed June 21, 2004, is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicants amended the specification at line 30 of page 2 to include --The metal or alloy may additionally support an anodized layer, in which case the anodized layer supports the outer layer 3 -

- Although Applicant amended with the intent to support the language of claim 13, the amendment to page 2, line 30, is clearly new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections – 35 USC § 102(b)

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1-3, 6 and 9-10 is rejected under 35 U.S.C. 102(b) as being anticipated by Robertson (US 5,855,969).

Robertson discloses a coated metal product (carrier) (column 2, lines 50-55) with the coating (outer layer) containing silicone polymer (column 5, lines 35-42) having one or more methyl or phenyl groups and TiO₂ (column 6, lines 25-35), which is equivalent to a polymer material with an inorganic main chain, where the silicone polymer is the main chain. Robertson discloses a laser beam blackens a zone of coating layer forming identification indicia (column 6, lines 35-39) resulting in the laser marked coating region having a visual appearance different from the visual appearance of the surrounding regions, which is shown in Figure 2. The reference discloses the coating results in a dense translucent form (column 5, lines 60-61) having pigmented fillers (column 5, lines 50-52). In instant claim 1, the phrase, "formed by a sol-gel process" introduces a

process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims.

7. Claims 7-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 25-26 are allowed.

Response to Arguments

9. Rejection under 35 U.S.C. 112, first paragraph, is maintained because the specification lacks support for "...an anodized layer which supports said outer layer". Applicant attempts to support the language of claim 13 by amending the specification to include --The metal or alloy may additionally support an anodized layer, in which case the anodized layer supports the outer layer 3 --, but introduces new matter into the specification with the amendment.

Applicants arguments to rejection made under 35 U.S.C. 102(b) as being anticipated by Robertson (US 5,855,969) has been considered but is unpersuasive. Applicant argues the phrase “and which contains TiO₂ coated mica” refers to “coating” and not to “silicon resin”. Examiner respectfully disagrees because the coating, cited in column 6, lines 25-35 comprises the silicon resin and the titanium dioxide coated mica. Examiner maintains Robertson discloses a coated metal product (carrier) (column 2, lines 50-55) with the coating (outer layer) containing silicone polymer (column 5, lines 35-42) having one or more methyl or phenyl groups and TiO₂ (column 6, lines 25-35), which is equivalent to a polymer material with an inorganic main chain, where the silicone polymer is the main chain. Applicant argues the siloxane matrix is translucent but not the surface. Robertson discloses the siloxane matrix of the coating layer has a dense translucent appearance, which results in the coating (outer layer) having a dense translucent appearance.

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1774

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186.. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lawrence Ferguson
Patent Examiner
AU 1774



B. HAMILTON HESS
PRIMARY EXAMINER